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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,882	11/09/1999	DON A. VAN DYKE	0100.9900960	7260
23418	7590	09/22/2004	EXAMINER	
VEDDER PRICE KAUFMAN & KAMMHOLZ			TREAT, WILLIAM M	
222 N. LASALLE STREET			ART UNIT	
CHICAGO, IL 60601			PAPER NUMBER	
			2183	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/436,882

Applicant(s)

VAN DYKE, DON A.

Examiner

William M. Treat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935.C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-17, and 19-20 is/are rejected.
- 7) ☒ Claim(s) 9 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claims 1-20 are presented for examination.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8, and 10-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Favor (WO 97/13194).

4. The arguments presented by the examiner in his three previous actions are still relevant to applicant's currently rejected claims and applicant's repetitious arguments and are hereby incorporated by reference. The relevant substance of the examiner's arguments is as follows. Favor teaches a system for emulating/simulating non-native, Intel X86 instructions using native RISC instructions as applicant's system does. An essential aspect of any system (applicant's or Favor's) which seeks to emulate an Intel system and its X86 instructions is that the architectural state (status flags, etc.) presented by the emulation system must be consistent with the architectural state which would be generated by the Intel system. Favor's system does this and does this using native instructions which contain a status flag modification enable bit which determines whether a particular flag or flags will be modified when a given native instruction is executed. This is, essentially, all applicant has limited his claims to in the rejected claims other than trivial claims to instruction type and system architecture also taught by Favor.

5. Claims 9 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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6. Where applicant in claims 9 and 18 has established a direct linkage between evaluation of the flag modification enable bit during execution of its native instruction to determine whether the non-native instruction flag associated with the enable bit will be modified by the native instruction, as some of applicant's arguments are directed to, the examiner has indicated allowability of those claims.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The examiner is suggesting the following, underlined changes to the language of claims 19 and 20 to particularly point out and distinctly claim applicant's invention.

Claim 19 would read: A method for processing program instructions comprising the steps of: receiving at least two non-native instructions containing data representing operational code and at least one non-native instruction flag; emulating the at least two non-native instructions using at least one native instruction including a flag modification enable bit; determining whether the at least one flag modification enable bit allows updating of at least one flag register associated with the at least one non-native instruction flag in response to emulating the at least two non-native instructions; and updating the at least one flag register in response to determining whether the at least one flag modification enable bit allows updating of the at least one flag.

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Claim 20 would read: The method of claim 19 including preventing updating of the at least one flag register in response to determining whether the at least one flag modification enable bit allows updating of the at least one flag.

10. Applicant's invention does not update just any flag register nor is the flag enable bit signaling updating of just any flag. The flag enabled for updating and the flag register of revised claims 19 and 20 are now, appropriately, specific. Also, claim 20 has been modified to make its language consistent with that of claim 19, its antecedent.

11. Any inquiry concerning this communication should be directed to William M. Treat at telephone number 703 305 9699. After Oct. 12, 2004, the examiner's phone number should be changed to (571) 272-4175. The examiner works at home on Wednesdays but may normally be reached on Wednesdays by leaving a voice message using his office phone number. The examiner also works a flexible schedule but may normally be reached in the afternoon and evening on three of the four remaining weekdays.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**WILLIAM M. TREAT
PRIMARY EXAMINER**